

REMARKS

I. Status of Rejections

In response to the revised Appeal Brief filed July 25, 2007, the Examiner has maintained:

(1) the rejection of claims 1-5, 9-15, 17-24, 26-32, 34-40, 44-50, 52-59, 61-67, 69-73, 157, and 158 under 35 U.S.C. § 102(b) as being anticipated by U.S. Patent No. 5,223,252 to Kolc et al. ("*Kolc*"); and

(2) the rejection of claims 6-8, 16, 25, 33, 41-43, 51, 60, 68, and 74 under 35 U.S.C. § 103(a) as being unpatentable over *Kolc* in view of U.S. Patent No. 5,753,215 to Mougín et al. ("*Mougín*").

Answer, page 3.

II. Response to Examiner's Arguments in the Answer

Appellants maintain that claims 1-74, 157, and 158 are not anticipated by *Kolc* nor obvious over *Kolc* in view of *Mougín* for the reasons set forth in the revised Appeal Brief filed July 25, 2007, and at least the following additional reasons.

In the Answer, the Examiner merely repeated the same allegations as set forth on pages 2-3 of the Office Action dated April 20, 2006. See Answer, page 3.

**A. Claims 1-5, 9-15, 17-24, 26-32, 34, 35, and 157
Are Not Anticipated by *Kolc***

Appellants respectfully maintain that the Examiner has failed to establish that each and every element in claims 1-5, 9-15, 17-24, 26-32, 34, 35, and 157 of the present invention is either expressly or inherently described in *Kolc*. Specifically, *Kolc*

does not expressly or inherently teach “the composition has a pH value effective to lanthionize the keratin fibers” as cited in, for example, claim 1 of the present invention for the reasons set forth in the revised Appeal Brief filed July 25, 2007.

It is improper for the Examiner to completely ignore this limitation, because it is well established that all limitations in a claim are material. *Glaxo, Inc. v. Novopharm, Ltd.*, 110 F.3d 1562, 42 U.S.P.Q. 2d 1257 (Fed. Cir. 1997). In addition, for a proper § 102 rejection, “[a] claim is anticipated only if each and every element as set forth in the claim is found, either expressly or inherently described, in a single prior art reference.” *Verdegaal Bros. v. Union Oil Co. of California*, 814 F.2d 628, 631, 2 USPQ2d 1051, 1053 (Fed. Cir. 1987).

The Examiner alleges that “this limitation does not indicate any specific values or ranges of pH to be used in the claimed composition.” Answer, page 6. The Examiner seems to require Appellants explicitly lay out the specific pH value in the claims. However, the Examiner has failed to point out any rules or regulations in support of this requirement.

Further, the Examiner cites *Brown v. 3M*, 265 F.3d 1349, 60 USPQ2d 1375 (Fed. Cir. 2001) in support of the § 102(b) rejection. Answer, pages 5-6. However, the holding in *Brown* is unrelated to the Examiner’s rejection. In *Brown*, the claim is directed to a system for setting a computer clock to an offset time to address the Year 2000 (Y2K) problem, which is applicable to records with year date data in “at least one of two-digit, three-digit, or four-digit” representations; and such a claim was held anticipated by a system that offsets year dates in only two-digit formats. *Brown*, 265 F.3d at 1351, 60 USPQ2d at 1376. In other words, *Brown* supports the general rule of

anticipation regarding species and genus, i.e., a species disclosed in the prior art falling into the scope of a genus claim anticipates the genus claim. See M.P.E.P. § 2131.02. Appellants fail to see how the holding of *Brown* applies in the instant appeal.

In addition, the Examiner alleges that “[A]ppellants have not shown on record the criticality of the pH values in the claimed composition.” Answer, page 6. However, evidence of criticality of the claimed range is required to rebut a *prima facie* case of obviousness if the claimed range overlaps with the range disclosed in the prior art, but is not required to rebut a § 102(b) rejection. See M.P.E.P. § 2144.05 III.

Finally, as the Examiner admits, “*Milady’s Hair Structure and Chemistry Simplified*” by Douglas D. Schoon, pages 191-192 (“Schoon”) submitted by Appellants on February 5, 2004, “teaches that lanthionization also interferes with permanent wave procedures (see page 192, paragraph[] 6).” Answer, page 7. As the Examiner further admits, *Kolc* “teaches a mild alkaline reducing composition for permanently waving or reshaping human hair.” Office Action dated April 20, 2006, page 2 (emphasis added); see *also* Answer, page 3. Therefore, contrary to the Examiner’s allegation that “Kolc’s composition is capable of lanthionizing the keratin fibers” (see Answer, page 7), one of ordinary skill in the art would not use the composition disclosed in *Kolc* to lanthionize human hair, since if it could lanthionize, it would interfere with its intended purpose of permanently waving.

Accordingly, Appellants respectfully request this § 102(b) rejection be withdrawn and reversed.

**B. Claims 36-40, 44-50, 52-59, 61-67, 69-73, and 158
Are Not Anticipated by *Kolc***

Appellants also respectfully maintain that the Examiner has failed to establish that *Kolc* expressly or inherently teaches each and every element in claims 36-40, 44-50, 52-59, 61-67, 69-73, and 158 of the present invention. Specifically, *Kolc* does not expressly or inherently teach a “pretreatment composition for lanthionizing keratin fibers,” which “is applied to said keratin fibers prior to applying a relaxing composition” as recited in, for example, claim 36 of the present invention.

The Examiner cites *In re Schoenwald*, 964 F.2d 1122, 22 USPQ2d 1671 (Fed. Cir. 1992), *In re Casey*, 370 F.2d 576, 152 USPQ 235 (CCPA 1967), and *In re Otto*, 312 F.2d 937, 136 USPQ 458 (CCPA 1963) in support of the § 102(b) rejection. Answer, pages 7-8. However, the Examiner’s arguments are misplaced. Unlike in *Schoenwald*, *Casey*, and *Otto*, Appellants do not rely on the utility or intended use of the composition. Instead, as clearly outlined in the revised Appeal Brief, pages 16-17, the composition disclosed in *Kolc* is a reducing composition as discussed above in subsection A and can simply not be the same as the pretreatment composition for lanthionizing keratin fibers being applied to the keratin fibers prior to applying a relaxing composition as recited in the instant claims. Therefore, this rejection is improper.

Accordingly, Appellants respectfully request this § 102(b) rejection be withdrawn and reversed.

**C. Claims 6-8, 16, 25, and 33
Are Patentable over *Kolc* in view of *Mougin***

Appellants respectfully maintain that the Examiner has failed to establish a *prima facie* case of obvious over *Kolc* in view of *Mougin* for claims 6-8, 16, 25, and 33 of the

present invention, because *Kolc* and *Mougin*, either alone or in combination, fail to teach or suggest that their compositions can be used to lanthionize keratin fibers or have "a pH value effective to lanthionize the keratin fibers" as cited in, for example, claim 1 of the present invention. The Examiner clearly erred in ignoring this limitation.

Indeed, *Mougin* teaches away from the high pH levels required for lanthionizing keratin fibers. According to *Mougin*, "cosmetic compositions according to the invention generally have a pH approximately between 7 and 7.2." *Mougin*, col. 6, lines 43-44. This pH value is not high enough to lanthionize hair. See the Declaration under 37 C.F.R. § 1.132 filed on November 14, 2005, page 2.

In addition, the Examiner has not met his burden to establish a *prima facie* case of obviousness since he has failed to point to any reason why one of ordinary skill in the art would modify the composition of *Kolc* "by incorporating the lysine, argining compounds and polyvalent salts" disclosed in *Mougin*.

"The key to supporting any rejection under 35 U.S.C. 103 is the clear articulation of the reason(s) why the claimed invention would have been obvious." M.P.E.P. § 2143 (rev. 6, Sept. 2007, page 2100-127) (emphasis added). In addition, "[r]ejections on obviousness cannot be sustained by mere conclusory statements; instead, there must be some articulated reasoning with some rational underpinning to support the legal conclusion of obviousness." *Id.* § 2143.01 IV (rev. 6, Sept. 2007, page 2100-140) (citing *KSR International Co. v. Teleflex Inc.*, 127 S. Ct. 1727, 1741, 82 USPQ2d 1385, 1396 (2007)).

Here, the Examiner's conclusory statement that *Mougin* is in the "analogous art" of a "hair straightening composition" is too vague to satisfy the burden on the Examiner as set forth in the M.P.E.P.

Further, "the polyvalent salts and the lysine, arginine compounds" are disclosed in *Mougin* as neutralizing agents for the pseudo-latex in its composition. However, because the composition of *Kolc* does not include pseudo-latexes that require neutralization, the Examiner has failed to point to any reason why one of ordinary skill in the art would replace cysteine compound disclosed in *Kolc* with "the polyvalent salts and the lysine, arginine compounds" disclosed in *Mougin*.

Accordingly, as the Examiner has failed to establish a *prima facie* case of obviousness for claims 6-8, 16, 25, and 33, this rejection is improper and should be reversed and withdrawn.

**D. Claims 41-43, 51, 60, 68, and 74
Are Patentable over *Kolc* in view of *Mougin***

Appellants respectfully maintain that the Examiner has failed to establish a *prima facie* case of obvious over *Kolc* in view of *Mougin* for claims 41-43, 51, 60, 68, and 74 of the present invention, because *Kolc* and *Mougin*, either alone or in combination, fail to teach or suggest a "pretreatment composition for lanthionizing keratin fibers," which "is applied to said keratin fibers prior to applying a relaxing composition" as recited in, for example, instant claim 36.

Moreover, as discussed in subsection C, the Examiner has failed to point to any reason why one of ordinary skill in the art would modify the composition of *Kolc* "by incorporating the lysine, arginine compounds and polyvalent salts" disclosed in *Mougin*.

Accordingly, as the Examiner has failed to establish a *prima facie* case of obviousness for claims 41-43, 51, 60, 68, and 74, this rejection is improper and should be reversed and withdrawn.

III. Conclusion

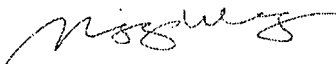
In view of the foregoing, Appellants respectfully request that the outstanding §102(b) and §103(a) rejections be reversed and withdrawn.

Please grant any extensions of time required to enter this Reply Brief and charge any additional required fees to our Deposit Account No. 06-0916.

Respectfully submitted,

FINNEGAN, HENDERSON, FARABOW,
GARRETT & DUNNER, L.L.P.

Dated: November 28, 2007

By: 

Ningling Wang
Reg. No. 52,412